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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,792

05/13/2005

Carlo M. Croce

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2613

21005

7590

10/09/2007

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EXAMINER

KETTER, JAMES S

ART UNIT

PAPER NUMBER

1636

MAIL DATE

DELIVERY MODE

10/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/530,792

Applicant(s)

CROCE ET AL.

Examiner

James S. Ketter

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 15-19 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 is/are allowed.
- 6) ☒ Claim(s) 2,3 and 5-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>(3)</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicant's election of Group II, claims 2-14, in the reply filed on 9 July 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1 and 15-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9 July 2007.

Claim 4 is allowed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 3 and 5-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hillman et al. (cited as B2 on the IDS filed 9 April 2007).

Claim 2 is drawn to an isolated nucleic acid molecule that comprises a nucleic acid sequence that encodes the recited protein. Claim 3 is drawn to an isolated nucleic acid molecule comprising SEQ ID NO:1 or a fragment thereof having at least 10 nucleotides. Claim 5 is drawn to a recombinant expression vector comprising the nucleic acid molecule of claim 3. Claim 6 is drawn to a host cell comprising the recombinant expression vector of claim 5. Claim 7 further

Art Unit: 1636

specifies that the molecule of claim 3 consists of a fragment of SEQ ID NO:1 having at least 10 nucleotides. Claim 8 further specifies that the nucleic acid molecule of claim 3 consists of a fragment of SEQ ID NO: 1 having 12-150 nucleotides. Claim 9 further specifies that the nucleic acid molecule of claim 3 consisting of a fragment of SEQ ID NO:I having 15-50 nucleotides. Claim 10 is drawn to an oligonucleotide molecule comprising a nucleotide sequence complementary to a nucleotide sequence of at least 5 nucleotides of SEQ ID NO:1. Claim 11 further specifies that the oligonucleotide molecule of claim 10 comprises a nucleotide sequence complementary to a nucleotide sequence of 5-50 nucleotides of SEQ ID NO:1. Claim 12 further specifies that the oligonucleotide molecule of claim 10 comprises a nucleotide sequence complementary to a nucleotide sequence of 10-40 nucleotides of SEQ ID NO:1. Claim 13 further specifies that the oligonucleotide molecule of claim 10 consists of a nucleotide sequence complementary to a nucleotide sequence of at least 10-150 nucleotides of SEQ ID NO:1. Claim 14 further specifies that the oligonucleotide molecule of claim 10 consists of a nucleotide sequence complementary to a nucleotide sequence of at least 18-28 nucleotides of SEQ ID NO:1.

Hillman et al. teaches, e.g., at SEQ ID NO:49 thereof, a nucleic acid which encodes the protein recited in instant claim 2, which comprises a fragment of 5-150 nucleotides of SEQ ID NO:1 of the present case, as recited and claimed variously in claims 3 and 7-9. At the paragraph bridging pages 11 and 12, fragment (oligo)nucleotides of this nucleic acid ranging from 5 to 1000 nucleotides in length are disclosed. At page 18, first full paragraph, and page 25, second paragraph, cloning of the nucleic acid into a vector, its transformation into a host cell, and expression therefrom is taught.

Art Unit: 1636

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Ketter whose telephone number is 571-272-0770. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JSK
25 September 2007



JAMES KETTER
PRIMARY EXAMINER